



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,079	07/12/2001	Jerry F. Coday	53625	1857

27148 7590 02/03/2003

POLSINELLI SHALTON & WELTE, P.C.  
700 W. 47TH STREET  
SUITE 1000  
KANSAS CITY, MO 64112-1802

EXAMINER

SINGH, SUNIL

ART UNIT	PAPER NUMBER
----------	--------------

3673

DATE MAILED: 02/03/2003

. Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/904,079

Applicant(s)

Coday et al.

Examiner

Sunil Singh

Art Unit

3673



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) 22-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 13, 14, 16-18, 20, 21, and 28 is/are rejected.
- 7) ☒ Claim(s) 7, 9-12, 15, and 19 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jul 12, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other:

Art Unit: 3673

### DETAILED ACTION

---

Claims 22-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 5.

Applicant argues that all the groups can be searched in a single search and would not be burdensome on the Examiner. The examiner would like to point out to applicant that applicant is entitled to one patent for one invention. Whether a search is burdensome or not is not the determining factor for restriction. It is abundantly clear that searching for the combination of a post shore and decking system is not the same as searching for a leg or beam/ledger as indicated below since they are classified in different classes and subclasses. Therefore, the restriction stands and claims 22-27 are hereby withdrawn from examination as being directed to non-elected claims.

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21 and 28, drawn to a post shore and decking system, classified in class 249, subclass 18.
- II. Claims 22-25, drawn to a leg, classified in class 52, subclass 736.1.
- III. Claims 26-27, drawn to a ledger, classified in class 52, subclass 739.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not

Art Unit: 3673

require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it is evidenced by claims 5, 20 and 21 that “holes” are not required. The subcombination has separate utility such as fence post.

3. Inventions Group I and Group III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it is evidenced by claims 5, 20 and 21 that the “top and bottom of the ledgers have a pair of parallel channels” are not required. The subcombination has separate utility such as a beam for a fence.

4. Inventions Group II and Group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group II has separate utility such as post for a stop sign; Group III has separate utility such as a beam for a traffic barricade. See MPEP § 806.05(d).

Art Unit: 3673

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

---

*Specification*

6. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;

Art Unit: 3673

(3) if a chemical compound, its identity and use;

(4) if a mixture, its ingredients;

(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

7. The abstract of the disclosure is objected to because "The present invention" should be omitted. Furthermore, the abstract does not adequately describe the invention. Correction is required. See MPEP § 608.01(b).

8. The disclosure is objected to because of the following informalities: at page 10 line 17, reference character "62" and "64" appears to be incorrect; page 17, "drophead 32" should be corrected to --drophead 30--; page 18 line 10, "hat" should be --cap--. Appropriate correction is required.

### *Drawings*

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "28" has been used to designate two different parts see Figure 9. At Figure 13, reference characters "26" and "28" appear to be pointing to the wrong members. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

10. The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

Art Unit: 3673

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

---

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Figure 5, reference character "82" and "84" do not point to "tabs".

### ***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-4, 17 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 line 23, "said channel" is recited; claim 1 line 21, "a pair of opposed channels" is recited; it is unclear how these two relate.

Claim 1 lines 22-23, "said outside leg flat projection" lacks clear antecedent basis.

Claim 1 line 30, "bottom" is recited, claims 1 line 29, "bottom" is recited; it is unclear how they are related.

Claim 17 line 2, "said extension leg member" lacks clear antecedent basis.

Claim 28 is similarly rejected as claim 1 above.

Art Unit: 3673

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claim 20 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Anderson (US 4984654) (see Fig. 2).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 5, 13, 16, 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Alessio et al. (US 4541509) in view of Steele (US 3784151).

D'Alessio et al. discloses a post shore and decking system comprising a non-symmetrical leg (see Fig. 3), U-shaped channel (22a,22b), frame members (see Fig. 1) attached by screw members to the channel (see Fig. 3). D'Alessio et al. discloses the invention substantially as claimed. However, D'Alessio et al. lacks a drophead member, ledger and joist member. Steele



Art Unit: 3673

teaches a drophead member, ledger and joist member (see Figs. 1-3). It would have been considered obvious to one of ordinary skill in the art to modify D'Alessio et al. to include the drophead member, ledger and joist member as taught by Steele in order to form the formwork used in the making of concrete floors.

17. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Alessio et al. in view of Steele as applied to claim 5 above, and further in view of Muller (US 944373).

D'Alessio (once modified) discloses the invention substantially as claimed. However, the (once modified) D'Alessio lacks a non-symmetrical extension leg. Muller teaches a non-symmetrical extension leg (see Fig. 5). It would have been considered obvious to one of ordinary skill in the art to further modify the (once modified) D'Alessio et al. to include the non-symmetrical leg as taught by Muller in order to control the height of the slab to be poured.

18. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over D'Alessio et al. in view of Steele as applied to claim 5 above, and further in view of Anderson (US 4984654).

D'Alessio (once modified) discloses the invention substantially as claimed. However, the (once modified) D'Alessio lacks a ledger with top and bottom channels. Anderson teaches a ledger with top and bottom channels (see Fig. 2). It would have been considered obvious to one of ordinary skill in the art to further modify the (once modified) D'Alessio et al. to include to channels as taught by Anderson in order to provide a means for retaining a joist member.

Art Unit: 3673

*Allowable Subject Matter*

---

19. Claims 1 and 28 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

20. Claims 2-4, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

21. Claims 7, 9-12, 15, 19 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

22. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

*Conclusion*

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford, can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Art Unit: 3673

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is (703) 308-2168.

---

Sunil Singh



Patent Examiner

Art Unit 3673

SS  
SS

1/24/03